

REMARKS

Claims 1-7 are pending in this application. Claims 1-6 stand rejected. By this Amendment, claim 1 has been amended and claim 7 has been added. The amendments made to the claims do not alter the scope of these claims, nor have these amendments been made to define over the prior art. Rather, the amendments to the claims have been made to improve the form thereof. In light of the amendments and remarks set forth below, Applicant respectfully submits that each of the pending claims is in immediate condition for allowance.

Claims 1-6 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Inoue (U.S. Patent No. 6,304,687) in view of Yamada (U.S. Patent No. 5,940,548). Applicant respectfully requests reconsideration and withdrawal of this rejection.

To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or combine references to arrive at the claimed subject matter. The prior art references must also teach or suggest all the limitations of the claim in question. See, M.P.E.P. § 706.02(j). A reference can only be used for what it clearly discloses or suggests. See, In re Hummer, 113 U.S.P.Q. 66 (C.C.P.A. 1957); In re Stencel, 4 U.S.P.Q.2d 1071, 1073 (Fed. Cir. 1987). Here, the references, whether taken individually or in combination, do not disclose or suggest the invention claimed by the Applicant.

Claim 1 is written in independent form. Claims 2-7 depend from and include all the limitations of claim 1 including "a photosensitive polymer filled in said groove, said photosensitive polymer having a negative refractive index temperature coefficient."

The Office Action admits that Inoue does not specifically teach that the material in claim 1 is a photosensitive material. The Office Action attempts to cure this deficiency using Yamada. However, Yamada fails to disclose a photosensitive material. The Office Action points to column 14, lines 45-50 for the teaching that the material is a photosensitive material having a negative refractive index. Applicant respectfully disagrees. This portion of Yamada merely discloses that a polyimide film has an absorption coefficient and α refractive index n_1 . There is no disclosure in Yamada that the material is a photosensitive material. Thus, the combination fails to disclose the expressly recited limitation in Applicant's claim.

Claims 2-7 depend from, and contain all the limitations of claim 1. These dependent claims also recite additional limitations which, in combination with the limitations of claim 1, are neither disclosed nor suggested by Yamada and are also believed to be directed towards the patentable subject matter. Thus, claims 2-7 should also be allowed.

Dependent claim 7 explicitly recites materials that can be used as the photosensitive polymer. These photosensitive polymers include n-vinyl carbazole and methacrylic monomer, omnidix, metacrylic monomer and acrylic monomer, acrylic monomer and epoxy, acrylic monomer, and polysilane. These materials are

not disclosed in either Inoue or Yamada. Thus, claim 7 is also allowable over the combination of Inoue and Yamada.

Applicant has responded to all of the rejections and objections recited in the Office Action. Reconsideration and a Notice of Allowance for all of the pending claims are therefore respectfully requested.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue.

If the Examiner believes an interview would be of assistance, the Examiner is welcome to contact the undersigned at the number listed below.

Dated: January 15, 2004

Respectfully submitted,

By /
Ira R. Blum

Registration No.: 42,336

DICKSTEIN SHAPIRO MORIN &

OSHINSKY LLP

1177 Avenue of the Americas - 41st Floor

New York, New York 10036-2714

(212) 835-1400

Attorney for Applicant

IRB/mgs